

REMARKS

Claims 1 through 15 are pending in this application. The specification has been amended at the suggestion of the Examiner and claims 1 and 10 amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the first full paragraph on page 5 of the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue.

Objection to the Specification

The Examiner objected to the specification asserting the lack of antecedent basis for the limitations of claim 10. In response, as suggested by the Examiner, the specification has been amended at page 5 to provide formalistic support for the limitations set forth in claim 15. Accordingly, withdrawal of the objection the specifications is solicited.

Claims 1, 3 through 11, 13 and 14 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Yuzuriha.

In the statement of the rejection, the Examiner referred to Figs. 1 through 4 and 8 through 10, and the related portions of the patent text, asserting the disclosure of a method corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.* 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir.

2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a significant difference between the claimed methods and the methodology of Yuzuriha et al. that scotch the factual determination that Yuzuriha et al. disclose a method identically corresponding to those claimed.

Specifically, each of independent claims 1 and 10 has been clarified to recite after planarization, etching is conducted to remove a portion of the dielectric material forming a step between the dielectric material and the remaining polish stop layer having a height substantially equal to the remaining polish step layer. No such manipulative step is disclosed or suggested by Yuzuriha et al.

Indeed, adverting to column 11 of Yuzuriha et al., lines 35 et seq., it is disclosed that etching is limited to less than the thickness of the inner wall oxide film which is 120nm; whereas, the height of the silicon nitride poly stop layer 4 is 150nm.

Moreover, Applicants separately argue the patentability of claims 7, 8, 13 and 14 which require etching to form a step having a height of about 200Å to about 1500Å (claims 7 and 13) or 500Å to 1000Å (claims 8 and 14) with respect to the upper surface of the poly stop layer.

The above argued differences between the claimed methods and the methodology of Yuzuriha et al. undermine the factual determination that Yuzuriha et al. disclose a method identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 3 through 11, 13 and 14 under 35 U.S.C. §102 for lack of novelty as evidenced by Yuzuriha et al. is not factually viable and, hence, solicit withdrawal thereof.

Claims 1 through 4, 6 and 9 through 12 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Shimizu.

In the statement of the rejection, the Examiner referred to Figs. 1 through 8 and related portions of the patent text, asserting the disclosure of the method corresponding to those claimed. This rejection is traversed.

Again, the factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc., supra; Crown Operations International Ltd. v. Solutia Inc., supra*. There are significant differences between the claimed methods and Shimizu's method that scotch the factual determination that Shimizu discloses a method identically corresponding to those claimed.

Specifically, adverting to Figs. 7 and 8 of Shimizu, it should be apparent that the etching step conducted on oxide trench filled 109 is not, and can not possibly be, sufficient form a step having a height substantially equal to the height of the remaining polystop layer because of the elevated central portion of trench filled 109 subsequent to etching.

The above argued difference in manipulative steps between the claimed methods and Shimizu's method undermines the factual determination that Shimizu discloses a method identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., supra; Kloster Speedsteel AB v. Crucible Inc., supra*. Applicants therefore, submit that the imposed rejection of claims 1 through 4, 6 and 9 through 12 under 35

U.S.C. §102 for lack of novelty as evidenced by Shimizu is not factually viable and, hence withdrawal thereof.

Claims 2, 12 and 15 were rejected under 35 U.S.C. §103 for obviousness predicated upon Yuzuriha et al. in view of the acknowledged prior art.

Claim 15 was rejected under 35 U.S.C. §103 for obviousness predicated upon Shimizu in view of the admitted prior art.

Each of the above rejections under 35 U.S.C. §103 is traversed. Specifically, claims 2, 12 and 15 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejections of claim 1, under 35 U.S.C. §102 for lack of novelty as evidenced by Yuzuriha et al. and Shimizu. The acknowledged prior art does not cure the previously argued deficiencies of Yuzuriha et al. and Shimizu.

Applicants, therefore, submit that the imposed rejection of claims 2, 12 and 15 under 35 U.S.C. §103 for obviousness predicated upon Yuzuriha et al. in view of the acknowledged prior art, and the imposed rejection of claim 15 under 35 U.S.C. §103 for obviousness predicated upon Shimizu in view of the acknowledged prior art, are not factually or legally viable and, hence, solicit withdrawal thereof.


Based upon the foregoing, it should be apparent that the imposed objection and rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

Application No.: 10/759,207

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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